

YOR.523

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Paul Andrew Moskowitz

Serial No.: 09/846,830

Group Art Unit: 2645

Filed: May 1, 2001

Examiner: Hoosain, Allan

For: **SYSTEM AND METHOD FOR MAKING TELECOMMUNICATION CALLS**

Honorable Commissioner of Patents  
Alexandria, VA 22313-1450

**DECLARATION UNDER RULE 37 C.F.R. § 1.131**

Sir:

We, Sam Dinkin, Stephen J. Boies, Paul Moskowitz, and Philip S. Yu, do hereby state

that:

- 1) We are the inventors of the above-identified application.
- 2) The **SYSTEM AND METHOD FOR MAKING TELECOMMUNICATION CALLS** was known to us earlier than July 14, 2000, as shown in the enclosed Invention Disclosures (Exhibit 1 and Exhibit 2). The dates of creation of the Invention Disclosures (Exhibit 1 and Exhibit 2) are earlier than July 14, 2000 and the dates thereof have been redacted.
- 3) The contents of the enclosed Invention Disclosures (Exhibit 1 and Exhibit 2) have been incorporated into the specification of the present invention, upon which claims 1-5, 12, and 32-67 are based.

For example, the Invention Disclosure (Exhibit 1) disclose a system and method of natural language telephone name service (e.g., see Invention Disclosure (Exhibit 1) at Title of

Serial No. 09/846,830  
Docket No. YOR920000311US1  
(YOR.523)

2

disclosure), which can be found in the specification (e.g., on page 3, lines 9-11; page 4, lines 13-19).

The Invention Disclosure (Exhibit 1) also describes the invention as a name service for telephones that is capable of being connected using a natural language word (e.g., see Invention Disclosure (Exhibit 1) at Description), which can be found in the specification (e.g., on page 4, lines 13-19). The Invention Disclosure (Exhibit 1) states that some of the popularity of the world wide web is attributable to the ability to type in a natural language word and be connected.

The Invention Disclosure (Exhibit 1) further describes that 800 numbers are hard to remember and have limited availability of format (e.g., see Invention Disclosure (Exhibit 1) at page 1, Description), which can be found in the specification (e.g., on page 1, lines 15-20).

The Invention Disclosure (Exhibit 1) further describes that telephone number to letter translation is limited. The Invention Disclosure (Exhibit 1) states that 411 information also is geographically limited and has limitations on naming conventions (e.g., see Invention Disclosure (Exhibit 1) at page 2, Description), which can be found in the specification (e.g., on page 1, line 21 to page 3, line 4).

Also, the Invention Disclosure (Exhibit 1) further states that the existing numbering convention does not have enough numbers for everyone in the country to have their own toll-free number and the existing addressing system does not have the capacity to provide every pervasive device a unique (e.g., unambiguous) name (e.g., see Invention Disclosure (Exhibit 1) at page 2, Description), which can be found in the specification (e.g., on page 1, line 21 to page 3, line 4).

4) Regarding the present invention, the Invention Disclosure (Exhibit 1) discloses a plurality of entry modalities, for example, telephones with numbers and telephones that have no numbers, such as voice terminals, multi-office workers, mobile workers, etc. (e.g., see Invention

Serial No. 09/846,830  
Docket No. YOR920000311US1  
(YOR.523)

3

Disclosure (Exhibit 1) at page 2; Solution: 7. Natural language phone directory), which can be found in the specification (e.g., on page 3, lines 9-19, and page 10, lines 1-7).

The Invention Disclosure (Exhibit 1) further states that users type in or say a word or natural language phrase instead of a number. For example, the Invention Disclosure (Exhibit 1) exemplarily describes an internet call placed by typing in or saying joe@alphaphone.com, which could be implemented by a name service such as 411 or the domain name service (DNS), or used in conjunction with unlisted numbers to guarantee that callers will have to pay a fee before calling. (e.g., see Invention Disclosure (Exhibit 1) at page 2; Solution: 7. Natural language phone directory at first paragraph), which can be found in the specification (e.g., on page 4, lines 13-19).

The Invention Disclosure (Exhibit 1) further discloses that the DNS style addressing exemplarily could be similar to internet addressing, for example, in which each phrase or word would be registered like an internet name (e.g., see Invention Disclosure (Exhibit 1) at page 2; Solution: 7. Natural language phone directory at first paragraph), which can be found in the specification (e.g., on page 4, lines 13-19).

The Invention Disclosure (Exhibit 1) exemplarily discloses that a server, which is hooked up to the web/PSTN, can answer the call, parse the words or wording of the address, look up numbers and/or addresses associated with the word or wording, and place the call (e.g., see Invention Disclosure (Exhibit 1) at page 2; Solution: 7. Natural language phone directory at third paragraph; System), which can be found in the specification (e.g., on page 4, lines 13-19).

The Invention Disclosure (Exhibit 1) exemplarily discloses that the address can include a telephone number, an ip number or other information sufficient to connect a call. The name can include a word, a phrase including names, and/or words or phrases (e.g., see Invention

Serial No. 09/846,830  
Docket No. YOR920000311US1  
(YOR.523)

4

Disclosure (Exhibit 1) at page 2; Solution: 7. Natural language phone directory at fifth paragraph; Address), which can be found in the specification (e.g., on page 6, line 4 to page 9, line 21).

The Invention Disclosure (Exhibit 1) discloses exemplary proposed claims which further describe the invention. For example, the exemplary proposed claim 1 includes a server, a database including a list of telephone addresses and names, the ability to connect an audio call when presented with a name, and a registry system (e.g., see Invention Disclosure (Exhibit 1) at Claims; at pages 2-3, bridging paragraph), which can be found in the specification (e.g., on page 15, line 25 to page 22, line 2).

The Invention Disclosure (Exhibit 1) discloses exemplary proposed claim 2, which includes natural language parsing (e.g., see Invention Disclosure (Exhibit 1) at Claims; at page 3), which can be found in the specification (e.g., on page 9, line 26 to page 11, line 7).

The Invention Disclosure (Exhibit 1) discloses exemplary proposed claim 5, in which some of the numbers/addresses in the database are one or more of otherwise unreachable, unlisted, etc. (e.g., see Invention Disclosure (Exhibit 1) at Claims; at page 3), which can be found in the specification (e.g., on page 5, lines 3-11).

The Invention Disclosure (Exhibit 1) discloses exemplary proposed claim 14, in which multiple parties share the same address (e.g., an ambiguous address), but receive calls from different callers based on the attributes of the callers (e.g., see Invention Disclosure (Exhibit 1) at Claims; at page 3), which can be found in the specification (e.g., on page 4, lines 20-27, page 5, lines 1-11, page 13, lines 16-21, page 14, line 11 to page 15, line 20, and page 19, lines 4-19).

The Invention Disclosure (Exhibit 1) discloses exemplary proposed claim 15, in which multiple parties share the same address (e.g., an ambiguous address), but the answer to a natural

Serial No. 09/846,830  
Docket No. YOR920000311US1  
(YOR.523)

5

language challenge determines the extension (e.g., see Invention Disclosure (Exhibit 1) at Claims; at pages 3-4, bridging paragraph), which can be found in the specification (e.g., on page 4, lines 20-27, page 5, lines 1-11, page 13, lines 16-21, page 14, line 11 to page 15, line 20, and page 19, lines 4-19).

5) The above clearly evidences a completion of the invention in this country before the filing date (e.g., July 14, 2000) of Provisional Application No. 60/218,469 on which U.S. Application Serial No. 10/332,889 to Stern, which was published as U.S. Application Publication 2004/0132433A1, is based.

6) In the alternative, we declare that the claimed invention was conceived prior to July 14, 2000 (e.g., as shown by the attached Invention Disclosures (Exhibit 1 and Exhibit 2) having dates (now redacted) prior to July 14, 2000) and that, coupled with due diligence from a date before July 14, 2000, the invention was constructively reduced to practice on May 1, 2001.

That is, the Invention Disclosure materials (Exhibit 1 and Exhibit 2) having dates (now redacted) prior to July 14, 2000, were forwarded to Stephen C. Kaufman, Senior Attorney, IP Law Department of International Business Machines Corporation prior to July 14, 2000, for review in accordance with standard International Business Machines Corporation procedures, and a U.S. patent application was prepared in due course in accordance with standard International Business Machines Corporation procedures.

The Invention Disclosure (Exhibit 2, page 5, Final Decision History) clearly shows that the application of the present invention was decided upon and docketed internally by International Business Machines Corporation prior to July 14, 2000, in accordance with standard International Business Machines Corporation procedures on May 9, 2000. The Invention Disclosure (Exhibit 2, page 5, Final Decision History) clearly shows that the decision was

Serial No. 09/846,830  
Docket No. YOR920000311US1  
(YOR.523)

6

entered by Anni Offenbacher of International Business Machines Corporation in accordance with standard International Business Machines Corporation procedures on May 11, 2000, which is just prior to the effective date of July 14, 2000 of the Stern reference.

We declare that, subsequent to the internal docketing and entering of the application for the present invention, Applicants diligently prepared the application in accordance with standard International Business Machines Corporation procedures, as shown, for example, by the Morgan & Finnegan Office Memorandum (Exhibit 3) from Angus Gill, a Technical Advisor at Morgan & Finnegan, to Mark J. Schildkraut on September 25, 2000 regarding the proposed patent application.

Particularly, the Morgan & Finnegan Office Memorandum (Exhibit 3) shows that a draft disclosure, claims, and drawings for the proposed patent application, along with a file folder and a video tape of an interview with an inventor, were forwarded on September 25, 2000.

Thus, the preparation of the draft disclosure, claims, and drawings clearly were prepared, and the video taped interview with the inventor clearly was conducted, during the intervening time period between the entry of the decision to proceed with the present application on May 11, 2000 and the forwarding of the September 25, 2000 Memorandum (Exhibit 3).

We hereby declare that revisions to the draft disclosure, claims, and drawings were performed in due course in accordance with standard International Business Machines Corporation procedures following the forwarding of the September 25, 2000 Memorandum (Exhibit 3).

We also declare that Applicants diligently prepared the application in accordance with standard International Business Machines Corporation procedures, as shown, for example, by the Morgan & Finnegan, LLP letter (Exhibit 4) dated June 6, 2001, which reports the filing of the

Serial No. 09/846,830  
Docket No. YOR920000311US1  
(YOR.523)

7

final draft of the patent application with the U.S. Patent and Trademark Office on May 1, 2001, for the present invention, to Stephen C. Kaufman, Esq., Senior Attorney, International Business Machines Corporation. The filing of the U.S. Patent application shows a constructive reduction to practice of the present invention.

We hereby declare that revisions to the draft disclosure, claims, and drawings were performed in due course in accordance with standard International Business Machines Corporation procedures in the intervening time between the date of the September 25, 2000 Memorandum (Exhibit 3) and the filing of the final draft of the patent application with the U.S. Patent and Trademark Office on May 1, 2001 (as shown in the Morgan & Finnegan, LLP letter (Exhibit 4) dated June 6, 2001).

7) The facts above in 5) clearly show a completion of the invention in the U.S. before July 14, 2000. Alternatively, the facts in 6) above show a conception of the invention, prior to July 14, 2000, and due diligence from just before July 14, 2000 to the filing date (i.e., the constructive reduction to practice) of the application on May 1, 2001.

We hereby declare that all statements made here of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Serial No. 09/846,830  
Docket No. YOR920000311US1  
(YOR.523)

8

Further declarants sayeth not.

Date: \_\_\_\_\_

\_\_\_\_\_  
Sam Dinkin

Date: \_\_\_\_\_

\_\_\_\_\_  
Stephen J. Boies

Date: \_\_\_\_\_

\_\_\_\_\_  
Paul Moskowitz

Date: \_\_\_\_\_

\_\_\_\_\_  
Philip S. Yu